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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/477,470      01/04/00      BYKER

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EXAMINER

MMC2/0621

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LESTER, F

ART UNIT

PAPER NUMBER

2873

DATE MAILED:

06/21/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Office Action Summary**Application No.  
**09/477,470**

Applicant(s)

Byker

Examiner

**E.A. Lester**

Group Art Unit

**2873**☐ Responsive to communication(s) filed on \_\_\_\_\_.☐ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**☒ Claim(s) 11-23 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.☒ Claim(s) 11-23 is/are rejected.☐ Claim(s) \_\_\_\_\_ is/are objected to.☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.**Application Papers**☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☒ Notice of References Cited, PTO-892☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Specification*

1. The Applicant is requested to please update the status of prior applications by amendment.
2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
3. The Applicant should note that though there appears to be no new subject matter in the cancelled claims 1-10, these claims are not the **original** claims of the parent application, Serial number 06/846,354, from which the claimed invention currently relies on the parent application for the earliest filing date. Originally there were 40 claims filed, and a restriction requirement was made. However, please note that the presently claimed invention has been amended beyond the restriction requirement of Serial number 06/846,354 (paper #5, mailed 12-3-87).

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 11-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

✓ With respect to claims 11, 17, 20 and 22 at line 4, there exists no antecedent basis for "the potential difference applied."

✓ With respect to claim 15 at line 4, there exists no antecedent basis for "the continuously variable transmittance component." (emphasis added by the Examiner)

With respect to claim 16 at line 3, there exists no antecedent basis for "electrode layers."

All dependent claims not specifically mentioned incorporate the indefiniteness of the claims from which they depend, respectively.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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5. Claims 11-23 are rejected under the judicially created doctrine of double patenting over claims 1-31 of U. S. Patent No. 5,128,799 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

The subject matter recited in claims 11-23 of the application comprising an electrochromic device having the following elements and/or limitations:

a single-compartment, self-erasing, solution variable transmittance component that provides continuously variable transmittance over a range of transmittance as a function of the potential difference applied, and wherein the continuously variable transmittance component comprises an acrylic material and a UV stabilizer;

wherein the acrylic material is a thickening material;

wherein the acrylic material is a gel;

wherein the sheet resistance of a transparent electrode layer of the device is less than 40 ohms per square;

where the device is gray-scale controllable over a range of transmittance, by applying potential differences between electrode layers of the device of 0.2 to 1.4 volts;

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wherein the device is an electrochromic window that has an area of at least about 162 square centimeters;

and wherein the current flow during normal device operation is 20 milliamperes per square centimeter or less;

also a compound that may be used in the device having a formula V (note the specification and claims for compound details;

is fully disclosed in the patent. The allowance of these claims would extend the rights to exclude already granted in claims 1-31 of the patent, that right to exclude covering the device comprising the patented claimed invention. The transitional phrase "comprising" does not exclude the presence of elements other than what are recited in the patent claims. Because of the phrase "comprising" the patent claims not only provide protection to the combination of claimed elements in the patent, but also extends patent coverage to the disclosed combination claimed in the present application. Likewise, if allowed, the claims of the present application, because of the phrase comprising, not only would provide patent protection to the claimed combination as delineated above, but would also extend patent coverage to the combination of elements, already disclosed and covered by the patent claims. Thus the controlling fact is that the patent protection of the device, fully disclosed in and covered by the claims of the patent, would be extended by the allowance of the claims in the present application.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application

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which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

See also MPEP § 804.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(f) he did not himself invent the subject matter sought to be patented.

6. Claim 23 is rejected under 35 U.S.C. 102(a) as being clearly anticipated by Applicant's disclosure at page 25, lines 3-20 of the specification.

The compound of claim 23 is fully and completely disclosed in the specification and is disclosed as being "a known compound."

Alternatively:

7. Claim 23 is also rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

The claimed compound is disclosed as "known," but there is no indication that the Applicant was/is the inventor.

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*Conclusion*

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to E.A. Lester whose telephone number is (703) 308-4943. The examiner can normally be reached on Monday-Friday (except for first Fridays of a biweek) from about 8:30 am to 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps, can be reached on (703) 308-4883. The fax number for Technology Center 2800 is (703) 308-7724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Evelyn A. Lester  
Patent Examiner  
AU 2873  
June 19, 2000